

### **REMARKS**

This application has been reviewed in light of the Final Office Action dated December 9, 2008. Claims 1, 2, 4-8, and 10-13 are currently pending and stand rejected. By the present amendment, claims 1, 2, 6-8, and 12-13 have been amended. All subject matter of the amended independent claims has been previously presented as part of claims 6 and 12. Thus, no new matter has been added, nor have any new issues been raised that would require a new search. Reconsideration of the claim rejections is requested in view of the above claim amendments and following remarks.

#### **Rejections under 35 U.S.C. 112, First Paragraph**

By the Office Action, claims 1, 2, 7, 8 and 13 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner contends that the claims contain subject matter which is not described in the specification in such a way as to reasonably convey that the inventors had possession of the claimed invention at the time the application was filed.

In particular, the Examiner asserts that the subject matter claiming that the impulse purchase message is transmitted “using an out of band frequency which is *different than content providing frequencies*” is not supported in the specification. The Examiner states that while cancelled claim 3 disclosed using an out of band frequency, no part of the application as filed disclosed the “different than content providing frequencies” limitation.

The applicants respectfully disagree. Fig. 2 clearly demonstrates that the impulse purchase request is transmitted on a different frequency than that used to transmit content. As described on page 6, lines 2-3 of the specification, block 245 in Fig. 2 represents “a means for communicating the desired impulse purchase.” Meanwhile, lines 17-18 of page 6 clearly describe that “the protected digital data streams that include broadcast programs” are transmitted over path 229. Fig. 2 makes it very clear that block 245 does not use path 229 to transmit the impulse purchase request.

To be stated another way in terms of what “out-of-band” means in view of the subject matter of canceled Claim 3 which is now incorporated in Claim 1; page 7, lines 11-16 describes the use of two different path ways for the transmission of authorization information 227 which can also be transmitted in an out of band frequency. Specifically, “communicating the authorization information 227 is through EMM 213, which may be transmitted in a form that is interleaved with the program [i.e., same frequency], or alternatively transmitted through a separate channel 227, for example using an out-of-band frequency [i.e., a different frequency than used for transmitted a program/content],” (page 7, lines 11-14 of the specification, emphasis added).

Hence, the specification explicitly defines what “out-of-band” means as being a different frequency than used for the content. This example would apply for claimed “impulse purchase selection transmits the selecting via an out of band frequency” which part of Claim 3 at the time the application was filed, and would be understandable to any person skilled in the art by either reading the specification or by knowing what the term “out-of-band” means as to satisfy 35 U.S.C. 112, first paragraph requirements..

Thus, for at least the reasons discussed above, applicants believe that claims 1, 2, 7, 8 and 13 satisfy the written description requirement in 35 U.S.C. 112, first paragraph. Reconsideration of the rejection is respectfully requested.

**Rejections under 35 U.S.C. 103 (a)**

By the Office Action, claims 1, 2, 4-8, and 10-13 are rejected under 35 U.S.C. 103 (a) as being unpatentable over U.S. Patent Publication 2002/0044658 to Wasilewski et al. (hereinafter Wasilewski) in view of U.S. Patent No. 6,697,489 to Candelore et al. (hereinafter Candelore). Applicants respectfully assert that amended claims 1, 2, 7, 8 and 13, at the very least, are patentable over the cited references taken alone or in combination.

Wasilewski is directed towards a cable television system providing conditional access to particular content. Wasilewski discloses a cable television system from which programs are broadcast to the set top units of clients. These set top units are configured to receive and selectively decrypt the programs based on that client's access privileges. As part of the system in Wasilewski, a user may make impulse purchases through a set top unit to request a certain program for viewing.

Wasilewski does not, however, teach or suggest an access device comprising, *inter alia*, "means for generating a billing record in response to the receipt of the authorization key," as recited in amended claims 1 and 2, and essentially recited in amended claims 7, 8 and 13.

The Examiner asserts on page 7 of the Office Action (regarding claim 6), that Wasilewski teaches this element in Fig. 24 and paragraph [0344]. The Examiner contends

that the cited portions of Wasilewski disclose that the head-end transmits customer billing information to update a database in entitlement agent. While this may be true, this in no way teaches or suggests that the access device (or set top box) generates the billing record. Neither the head-end nor the entitlement agent are part of the access device / set-top-box in Wasilewski. Fig. 3 of Wasilewski clearly demonstrates that the head-end is part the service provider's equipment which broadcasts content to clients. In contrast, the access device / set top box is the client (DHCT as referred to by Wasilewski) on the other side of the transmission medium between the service provider and the client. Therefore, generating a billing record at the head-end certainly is not the same as generating a billing record at the access device. Wasilewski teaches only the former, while the present invention claims the latter. Therefore, it is clear that Wasilewski does not teach or suggest this element of claims 1, 2, 7, 8 and 13.

In addition, Wasilewski does not teach or suggest that "the access device transmits the billing record to the service provider," as recited in amended claims 1 and 2, and essentially recited in amended claims 7, 8 and 13. As discussed above, Wasilewski discloses that the head-end generates the billing record. As would be expected, since Wasilewski teaches that the billing record originates at the service provider, no portion of Wasilewski remotely suggests transmitting the billing record to the service provider from the access device / set top box, as claimed by the present invention.

Furthermore, the only transmission of billing information suggested in Wasilewski is that the head-end transmits billing information to the database in the entitlement agent. As Figs. 3 and 24 make clear, this is an intra-service provider transmission. As such, it cannot be said to teach or suggest transmitting "the billing record

from the access device to the service provider,” i.e., a client-to-service-provider transmission. Therefore, Wasilewski certainly does not disclose or suggest all of the elements in amended claims 1, 2, 7, 8 and 13.

Candelore does not cure the deficiencies of Wasilewski. Candelore is directed to a method for securing control words. Candelore teaches receiving a scrambled digital signal and an encrypted control word in a descrambler, decrypting the control word with a key stored in the descrambler, and descrambling the digital signal using the decrypted control word.

Candelore does not disclose or suggest an access device with a “means for generating a billing record in response to the receipt of the authorization key,” as recited in amended claims 1 and 2, and essentially recited in amended claims 7, 8 and 13.

Candelore’s disclosure is clearly limited to the method of securing control words and decrypting digital content. Candelore simply makes no mention of generating billing records at the access device. The only content in Candelore which is remotely related to generating billing records is in Fig. 10 and col. 10, lines 8-19, which make clear that Candelore’s method of requesting and receiving service keys does not include generating a billing record at the access device in response to receiving the access key. Block 1050, which reads “send service key to decoder and bill the decoder’s account for IPPV program,” combines the actions of sending the service key and billing the account into the same step. Since the head-end / service provider sends the service key to the decoder, this combination strongly implies that the head-end / service provider generates the billing record.

Further, the present invention claims that the access device generates the billing record “in response to the receipt of the authorization key,” and then transmits this

record to the service provider. As mentioned above, however, Candelore discloses that billing the account is performed in the same step as sending the service key to the decoder. This directly contradicts and teaches away from the elements of claims 1, 2, 7, 8 and 13 which recite that the billing record is generated by the access device “in response to the receipt of the authorization key.” Thus, Candelore certainly does not teach or suggest an access device with a means for generating billing records, as essentially recited in claims 1, 2, 7, 8 and 13 as amended.

Candelore also fails to disclose or suggest that “the access device transmits the billing record to the service provider,” as recited in amended claims 1 and 2, and essentially recited in amended claims 7, 8 and 13. As discussed above, it is quite clear that Candelore does not disclose generating a billing record at the access device. In addition, Fig. 10 of Candelore strongly implies a system similar to Wasilewski, where the billing record is generated by the service provider. Further, nowhere does Candelore even remotely suggest that the access device ever has a billing record. As a result, Candelore certainly does not teach or suggest the access device transmitting the billing record to the service provider as claimed by the present invention.

In fact, Candelore actually teaches away from this element of the present invention. In col. 5, lines 8-9, Candelore states “Purchase records may be ... forwarded by phone to a billing center.” This is the only portion of Candelore where transferring billing records is mentioned. Candelore never mentions or remotely suggests that the purchase records are transmitted from the access device to the service provider. Therefore, it is quite clear the Candelore fails to teach or suggest this element of amended claims 1, 2, 7, 8 and 13 as well.

Since the cited art fails to disclose or suggest all of the features of independent claims 1, 2, 7, 8 and 13, as amended, these claims are believed to be distinct and patentable over Wasilewski and Candelore, taken singly or in combination. Accordingly, applicants respectfully assert that the above-mentioned independent claims are in a position for allowance for at least the stated reasons. Additionally, applicants respectfully assert that claims 4-6 and 10-12 are patentable at least by virtue of their respective dependencies from the aforementioned independent claims. Reconsideration of the rejection is earnestly solicited.

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims now pending in the application are in condition for allowance. Early and favorable reconsideration of the case is respectfully requested.

Respectfully submitted,

David Duffield

By: /Joel M. Fogelson/

Joel M. Fogelson  
Reg. No. 43,613

THOMSON LICENSING, INC.  
Patent Operations  
P.O. Box 5312  
2 Independence Way  
Princeton, NJ 08543-5312  
May 21, 2009